

5     **REMARKS**

**Paragraph 1 of the Office Action**

          The patent to Negreanu is a design patent, U.S. Pat. Des. 373,171. Applicant hopes that this information satisfies the Examiner's request.

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**Paragraphs 2-3 of the Office Action**

          Claims 1-5 are rejected under 35 USC §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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          Claims 1 and 5 have been amended are now believed to be in compliance.

          Withdrawal of the rejection is respectfully requested by the applicant.

**Paragraph 4-14 of the Office Action**

20       Claims 1-5 have been rejected under various grounds based on the prior art discussed within the Office Action. Applicant will examine each reference here instead of replying to each individual paragraph, as the comments would otherwise be cumulative.

25       Applicant has amended claim 1 to include the limitation of the ring being made of a buoyant material. This advantage ensures that the ring is not lost when it falls off the fishing rod as it will float in water. Claims 4 and 5 include a loop member that is attached to the ring. One end of a tether is attached to the loop and another end of the tether is attached to an object that is not part of the fishing line. Figure 1 depicts a fence though any object not attached to the fishing line would suffice. The reasoning for the tether is to ensure the ring is not lost when it falls off of the fishing rod. A person fishing, from land or from a boat, may easily loose the ring, even it floats, because they may be busy reeling in a fish. During this time, the ring will have an opportunity to float away. Additionally, the water temperature may be cold which will give a reason to a person fishing to not enter the water to retrieve the ring. New claim 6 includes the limitation of the loop and tether. The loop in claim 6 is defined as being closed, which is fully disclosed in the figures as submitted. Though it is conventional to define a loop as a

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5 closed member, where as a clip is a loop having a break therein, applicant has further included this limitation to better define the current device.

The Examiner, it is respectfully submitted, has not found all of the elements to form the device as shown by the applicant. Alternatively, should such a combination be found, it is also believed that the Examiner has improperly used applicant's device as a  
10 recipe to combine those elements. The art cited will be discussed in turn below.

Cafarella has been cited, generally, for showing a ring being used as a bite indicator. Applicant concedes the citation of Cafarella as generally showing a ring used in this manner. In multiple paragraphs Smith, Mulchintock and Cafarella are cited for showing a buoyant material being used in their construction. However, neither states that  
15 their material is being selected for its buoyant properties and their materials cited may be made to sink. Smith and Mulchintock are used in substantially the same manner in that they are attached to the rod and the line is extended through their devices. For this reason, only Smith will be discussed but all such discussions relate likewise to Mulchintock. Smith selects its materials based on the fact that they are relatively light.  
20 Smith extends the fishing line through its detector and then attaches the detector to the rod. Essentially then, Smith's detector is a removable eyelet. The rod is then cast with the detector attached to the rod. Once the slack has been brought up, the detector is released from the rod so that it hangs between two eyelets. Thus, the Smith device is not removable from the line without removing the line from the rod. Smith requires a  
25 lightweight material so that the detector does not fall to far downward and in the process pull the bated end of the line upwards. Smith does not mention buoyancy, as that feature is not required in the usage of that device. Cafarella mentions polyethylene but only for the purpose "that (it) provides a relatively hard slippery surface." Column 6, line 3. Cafarella does not mention a buoyant material or even a light material but only states that  
30 "the person fishing should select a torus weight compatible with the line weight and fishing conditions." Column 4, lines 65-67.

The use of Smith, Mulchintock and Carafella have led the Examiner combinations that are not supported within their disclosures, namely that they have chosen a buoyant material for the properties deemed valuable to applicant. Carafella has chosen it for its  
35 slippery nature so that it will slide along a pole and Smith has chosen a light weight

5 material so that the line is not overly burdened when the detector is removed from the rod and allowed to hang on the line. These citations cannot be combined to show the use of a buoyant material as such material is not discussed and there is no motivation to find a buoyant material within their documents. The lack of motivation points to hindsight reconstruction by the Examiner.

10 'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although  
15 couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting  
20 from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)). In the current case, there is no motivation as the motivation to use the materials discussed as those citations directs one down contrary lines of thought, i.e. slippery material is more suitable than rough material and that low weight places less drag on the fishing line. As applicant's device functions completely  
25 different from Smith and uses particular materials for a different reason than Carafella, there can be no motivation.

Mulchintock is cited for showing a ring 2. However, the ring of Mulchintock is not analogous to the loop of applicant's device. The ring of Mulchintock is used for facilitating the correct movement of the device with respect to the rod. The rings 4 of the  
30 Mulchintock device are attached to an elliptical element 3 and receive the fishing line itself. The movement of the fishing line causes the element to rotate and thus indicate that a fish has bit the line. The Examiner has indicated that this is analogous to a tether which is attached to the loop member of applicant's device. However, there is nothing within applicant's specification that would lead one to believe that the tether is analogous  
35 to the fishing line. In fact, the tether is specifically mentioned within the body of the claims while the fishing line is recited within the preamble. Additionally, one of the advantages of applicant's device is that the fishing is specifically not strung through the loop member or the ring. This allows a person to freely position applicant's device on a

5 fishing rod, over the line, without having to restring the fishing rod. Mulchintock relies on a rotational action of its device, again supported on the fishing line between to eyelets of the rod, to show that a fish has taken the line while applicant's device relies on movement of the ring up and off of the rod. Aside from the fact that the loop member of applicant's device serves no purpose other than to form an attachment for the tether, the  
10 loop member of applicant's device also does not require a particular axial orientation as is required by Mulchintock. Applicant's device does not attach to a rod and does not have specific requirements of axial alignment. For these reasons, the features of applicant's device are not found in Mulchintock and there can be no motivation as the usages are so wildly varied.

15 That the differences vary so greatly gives rise to the argument that the Examiner has impermissibly used hindsight reconstruction as no person would be motivated to look at the Mulchintock device in order to formulate applicant's device.

[T]he Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction  
20 manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.' [citations omitted]

25 In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), (in part quoting from In re Fine, 837 F.2d 1071, 1075; 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)). It is obvious that, within the meaning of the court's opinion, the current combination is found in isolated devices that would not lead to the conclusions found by the Examiner. In fact, the teaches of the prior art would lead away from applicant's device as they teach a  
30 device positioned on a fishing line and would therefore not require a loop as applicant teaches.

As to Cunningham, applicant is completely unaware of a loop being shown or used as is done in applicant's device. The Examiner states "a loop (where 48 is attached; see Figs. 4 and 5) attached to the ring member and a tether (48) attached at one end to the  
35 loop." This statement is highly confusing as applicant is not certain if the Examiner is saying the loop is 48 or the tether is 48. The area indicated by the reference numeral 48 (which is not, as an aside, shown in either figure 4 or 5) is a solid, arcuate keepers for

5 allowing the fishing line to “be trained through the keepers and the line restrained by the  
bight portions of the said keepers 46 and 48.” There is no mention of a tether, and there  
is no evidence that these are loops as defined within applicant’s specification.  
Additionally, the ring member (40) of Cunningham, is not attached to the loop but is  
attached to a plate (36) that is attached to a pair of rods extending away therefrom.

10 Eventually, the rods bend and extend upwardly and are combined together with a  
common end. The keeper (48) is extended between these to rods to form a place for  
receiving the fishing line. Again, Cunningham, like many of the previous devices, is  
positioned on the line itself and between eyelets of the fishing rod and is not to be tied to  
a tether, as a tether would only interfere with its operation, as it would also interfere with

15 the operation of Mulchintock. For this reason there can be motivation to combine  
Cunningham with the other references, but that is irrelevant in this case the elements  
themselves are simply not found in the Cunningham device.

For these reasons, it is believed that claim 1 and all claims depending therefrom,  
as well as claims 5 and 6, are in condition for allowance. The applicant courteously

20 requests withdrawal of the rejections.

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**CONCLUSION**

10           In light of the foregoing amendments and remarks, early consideration and  
allowance of this application are most courteously solicited.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Sean A. Kaufhold".

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